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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/534,840	09/21/2006	Wolfgang Braun	2945-174	8976
6449 7590 12/19/2008 ROTHWELL, FIGG, ERNST & MANBECK, P.C. 1425 K STREET, N.W. SUITE 800 WASHINGTON, DC 20005				
EXAMINER				
HALPERN, MARK				
ART UNIT		PAPER NUMBER		
1791				
NOTIFICATION DATE		DELIVERY MODE		
12/19/2008		ELECTRONIC		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

PTO-PAT-Email@rfem.com

# Office Action Summary

**Application No.**

10/534,840

**Applicant(s)**

BRAUN ET AL.

**Examiner**

Mark Halpern

**Art Unit**

1791

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-25 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☒ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SF/08)  
Paper No(s)/Mail Date 7/21/05.5/13/05
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_

## **DETAILED ACTION**

### ***Information Disclosure Statement***

1) The information disclosure statement filed 5/13/05 fails to comply with 37 CFR 1.98(a)(2), which requires a legible copy of each cited foreign patent document; each non-patent literature publication or that portion which caused it to be listed; and all other information or that portion which caused it to be listed. It has been placed in the application file, but the information referred to therein has not been considered.

Copies of the 5/13/05 IDS foreign prior art references listed on form PTO-1449 are not provided for review.

### ***Specification***

- 2) "STO 101/00/WO" and "(Fig. 1)" are to be removed from the Abstract.
- 3) "STO 101/00/WO" and "Applicant: Stora Enso Maxau GmbH & Co. KG" are to be removed from Page 1 of the Specification.

### ***Claim Objections***

- 4) Method claim 23 is to be presented in an independent form with claims 24-25 depending from claim 23.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5) Claims 1-25, are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1, line 3, in phrase "...in that it comprises..." it is not clear what "it" is.

Claims 1-4, 6, 23-24: the term "man-made" fibers is not clear. Does "man-made" mean "synthetic"? The term "synthetic" is also used in the claims.

Claim 4: the term "fully-synthetic" fibers is not clear. Also, does the invention disclose fibers that are other than "fully-synthetic"?

A broad range or limitation together with a narrow range or limitation that falls within the broad range or limitation (in the same claim) is considered indefinite, since the resulting claim does not clearly set forth the metes and bounds of the patent protection desired. See MPEP § 2173.05(c). Note the explanation given by the Board of Patent Appeals and Interferences in *Ex parte Wu*, 10 USPQ2d 2031, 2033 (Bd. Pat. App. & Inter. 1989), as to where broad language is followed by "such as" and then narrow language. The Board stated that this can render a claim indefinite by raising a question or doubt as to whether the feature introduced by such language is (a) merely exemplary of the remainder of the claim, and therefore not required, or (b) a required feature of the claims. Note also, for example, the decisions of *Ex parte Steigewald*, 131 USPQ 74 (Bd. App. 1961); *Ex parte Hall*, 83 USPQ 38 (Bd. App. 1948); and *Ex parte Hasche*, 86 USPQ 481 (Bd. App. 1949).

Claim 3 recites the broad recitation "at least 10 wt-% and no more than 30 wt-%", and the claim also recites "at least 15 wt-% and no more than 25 wt-%", which is the narrower statement of the range/limitation.

Claim 6 recites the broad recitation "less than 8 mm", the claim also recites "between 3 mm and 8 mm", and "between 4 mm and 7 mm", which are narrower statements of the range/limitation.

Claim 7 recites the broad recitation "at least 10 wt-% and no more than 80 wt-%", and the claim also recites "at least 20 wt-% and no more than 60 wt-%", which is the narrower statement of the range/limitation.

Claim 8 recites the broad recitation "at least 5 wt-%", and the claim also recites "at least 10 wt-%", "at least 20 wt-%", "no more than 50 wt-%", and "no more than 35 wt-%", which are narrower statements of the range/limitation.

Claim 11 recites the broad recitation "a polymer", the claim also recites "an alkylacrylate", and the claim also recites "butylacrylate", which are narrower statements of the limitation.

Claim 18 recites the broad recitation "a polymer", the claim also recites "a thermally-crosslinked polymer", and the claim also recites "a thermally-crosslinked copolymer", which are narrower statements of the limitation.

Claim 19 recites the broad recitation "a copolymer of an alkylacrylate", the claim also recites "butylacrylate", and the claim also recites "styrene", which are narrower statements of the limitation.

Claim 20 recites the broad recitation "a wax", and the claim also recites "paraffin wax", which is the narrower statement of the limitation.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6) Claims 1-9, 17, 23-25, are rejected under 35 U.S.C. 102(b) as being anticipated by Turner (GB 1,566,273).

Claims 1-4, 7-9: Turner discloses wallpaper made of 30-90% chemical pulp fibers, 10-70% synthetic polymeric material, and other usual additives like binders, fillers, such as talc or kaolin, and pigments (Pages 1-2).

Claims 5-6: polyester fibers are disclosed. The fibers are of 0.5-5.0 mm in length (Page 2, lines 5-10).

Claim 17: an additional wall-facing lower layer is disclosed.

Claims 23-25: Turner discloses wet papermaking method of making wallpaper from 30-90% chemical pulp fibers, 10-70% synthetic polymeric material, and other usual additives like binders, fillers, such as talc or kaolin, and pigments (Pages 1-2).

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7) Claims 10-16, 18-19, are rejected under 35 U.S.C. 103(a) as being unpatentable over Turner.

Claims 10-16: Turner discloses a binder and chemical additives. It would have been obvious to one skilled in the art at the time the invention was made that the binder and the chemical additives be of any material, including the claimed material in the amount required to satisfy the product requirements.

Claims 18-19: the additional wall-facing lower layer is disclosed of copolymers.

8) Claims 20-22, are rejected under 35 U.S.C. 103(a) as being unpatentable over Turner in view of Freeburn (6,461,475). An additional wall-facing lower layer is disclosed as per above claim 17, Turner fails to disclose that the lower layer contains wax. Freeburn discloses wallpaper where the wall-facing lower layer contains wax. It would have been obvious to one skilled in the art at the time the invention was made to combine the teachings of Turner and Freeburn, because the addition of wax of Freeburn would improve water repellency of the wallpaper of Turner as disclosed by Freeburn (col. 1, lines 30-50).

***Conclusion***

9) Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark Halpern whose telephone no. is 571-272-1190.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Steven Griffin can be reached on 571-272-1189. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only.

/Mark Halpern/  
Primary Examiner  
Art Unit 1791